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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,374	11/08/2001	Naoya Ichikawa	2809-0123P	5132

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1711

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DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,374

Applicant(s)

ICHIKAWA ET AL.

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 22-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

A new title is suggested.

Election/Restrictions

Applicant's election with traverse of Group III, claims 18-21, in Paper No. 8 of 3 March 2003 is acknowledged. The traversal is on the ground(s) that:

1) the "subject matter of the presently withdrawn product claims of Group IV (i.e. claims 22-25) significantly overlaps with that of the elected subject matter",

2) the preparation methods recited in the claims of presently withdrawn Groups I and II (i.e. claims 1-17) also significantly overlap with that of the elected subject matter", and

3) "in view of the overlapping subject matter, it is submitted that there is no significant burden placed on the Examiner to examine all of the claims".

This is not found persuasive because:

1) the subject matter of the elected claims is drawn to a rubber product wherein protein and the "protein decomposition product" are not detected. The subject matter of the Group IV claims requires particular nitrogen contents (presence of protein or "decomposition product"), as well as particular absorption values. While the claims of

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Group I recite similar characteristics as that of Group II for the separate products, the claims differ significantly by the recitations of Group IV. Similarly, a resin having ethylene and propylene units could not be considered to anticipate, or even render obvious, a polyethylene-propylene resin that has a particular melt-flow rate required.

2) Group III is drawn to a product, not a product-by-process. It is irrelevant that Groups I and II, drawn to separate processes, recite anything other than lack of detection of protein or "decomposition product". The Group III product does not require those steps to produce, since it may be accomplished using other methods.

3) Finally, due to the recitations of other features, and the fact that the Groups I and II claims do not recite a product, the inclusion of all four inventions for prosecution clearly presents an undue burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Applicants are urged to read a dictionary definition of "allergic". The term refers to the reaction, itself, and not to the reaction-causing composition. The term that should be used is "allergenic" in reference to the rubber. See the citation of *Webster's II New Riverside University Dictionary*, supplied, in this regard.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims do not clearly and positively recite what applicants are seeking for patent protection. Claim 18 recites a "low allergic (*sic*) natural rubber" without providing any details about the rubber constituent other than it is obtained "by a decomposition treatment of a protein". This is not logical or scientifically founded for the production of a rubber which requires monomeric constituents that are polymerized to form the rubber, in this case, naturally occurring isoprene. Nothing is required of the rubber otherwise, nor recited.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18 and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Tanaka et al ('407), Tanaka et al ('253), Tanaka et al ('358), Tanaka et al ('567) or Tanaka et al ('740), all newly cited.

The reference to Tanaka et al ('407) shows the contemplated natural rubbers at Table 6 (columns 16 and 17), Table 9 (column 18) and Table 12 (column 20).

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The reference to Tanaka et al ('253) teaches the concept at column 4 (lines 31-36) and the paragraph bridging column 4 to column 5. Further, note Table 6 (column 17), Table 9 (column 19), and Table 12 (column 21).

Note in Tanaka et al, at Table 1 (column 13), Table 6 (columns 16 and 17), Table 9 (column 18) and Table 12 (column 20).

In Tanaka et al ('567), note Figures 1-4, the paragraph bridging column 7 to column 8 and column 9 (lines 48-55). Further, note Example 1 at columns 11 and 12 and Table 1 at column 13.

In Tanaka et al ('740), note column 1 (lines 22-28), column 3 (lines 18-65) and column 5 (lines 18-42).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 703-308-2443. The examiner can normally be reached on Monday-Friday 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read "Nathan M. Nutter". The signature is fluid and cursive, with the first name "Nathan" being more prominent and the last name "Nutter" following in a similar style.

Nathan M. Nutter
Primary Examiner
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nmn
March 18, 2003